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any

59. (New) The refrigerator compartment as defined in claim 50 wherein said front and rear border members are each *in situ* injection molded in bonded relationship to said piece of glass.

60. (New) The refrigerator compartment as defined in claim 51 wherein said front and rear border members are each *in situ* injection molded in bonded relationship to said piece of glass.

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cut

61. (New) The refrigerator compartment as defined in claim 52 wherein said front and rear border members are each *in situ* injection molded in bonded relationship to said piece of glass.

Remarks

After careful consideration of the outstanding Office Action, this application has been amended accordingly, and favorable reconsideration on the merits thereof is at this time respectfully requested.

In the outstanding Office Action, the Examiner rejected all of the elected claims under "35 U.S.C. 103(a) as being unpatentable over Maier et al. (France 91 04 111) in view of Herrmann et al. (5,406,894)." Prior to setting forth the latter-quoted rejection, the Examiner made specific reference to the Supreme Court decision of Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) "for establishing a background for determining obviousness under 35 U.S.C. 103(a)." Though four criteria were specified, the undersigned will emphasize the first two before commenting upon the applied prior art.

The Examiner made specific reference to "Determining the scope and content of the prior art." The Court of Appeals, Federal Circuit in Panduit Corp. v. Dennison Manufacturing Co. (1 USPQ2d 1593, 1597) revisited the Graham decision and stated that page 467 of Graham dealing with the "several basic factual inquiries" leading toward a decision under Section 103 must include consideration of the prior art "in its entirety."

At page 1597, the Panduit court stated:

Among legal standards for determining *scope* and content of the prior art, for example, are: a prior patent must be considered in its entirety, *i.e.*, as a *whole*, including portions that would lead away from the invention in suit, *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); elements of separate prior patents cannot be combined when there is no suggestion of such combination anywhere in those patents, *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); and a court should avoid hindsight, *W.L. Gore & Associates, Inc.*, 721 F.2d at 1553, 220 USPQ at 313.

Even before the Graham and Panduit decisions, courts emphasized the impermissibility "within the framework of Section 103 to pick and chose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such a reference fairly suggests to one skilled in the art. "In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965). Courts, as well as Examiners, were urged to avoid "the tempting but forbidden zone of hindsight" (Locktite, 781 F.2d at 872, 228 USPQ 97,98).

The undersigned has emphasized the latter decisions and the various holdings thereof because the rejections set forth at the tope of page 3 of the outstanding Office Action evidences a recognition of the Examiner of

similarities which have been picked and chosen from the prior art absent the teachings of the prior art "as a whole."

First and foremost, it is amply evident from comparing the two patents cited/applied by the Examiner that each is, obviously, directed to a shelf for a refrigerator, but at this point the only comparison between the two is that made possible through the Examiner's hindsight referral to Applicant's disclosure. In the Maier et al. patent (FR 2 662 411 A1), the shelf 14 is a sliding shelf defined by a piece of glass 15 which is entirely peripherally surrounded by a border 16 which is indented in the areas 17, 18 (Figure 3). Herrmann et al., on the other hand, discloses a shelf assembly defined by two brackets 24, 24 (Figure 1) to which a glass shelf panel 28 is fixed by any number of different connectors, such as the studs 36 and keyhole fastening apertures 38 (Figure 2). The shelf assembly 20 is designed to be relatively easily assembled and disassembled and, when assembled, can be adjusted vertically by appropriately inserting hooks 32 of shelf brackets 24 into slots of vertical shelf tracks 34 (Figure 1). There is no sliding relationship anywhere disclosed in this patent relative to the shelf assembly 20 or the shelf panel 22 thereof, particularly with respect to the brackets 24, 24. One might then wonder, recognizing that the two patents *as a whole* are directed to different shelf structures, why the Examiner would turn to Figure 3 of Herrmann et al. and specifically the glass shelf which is "provided with a frame 60, 62 on the front edge and/or on the back edge for the purpose (sic) providing trim or leaving the edge portion untrimmed." The present invention has nothing to do with "trim" and does not claim "trim" structurally or functionally. Applicant's structure and corresponding function provides temperature conductivity and air flow in fresh or freezer compartments of a

refrigerator thereby preserving product/articles therein for a longer period of time and effectively increasing product life and less spoilage. The latter is Applicant's invention as disclosed and claimed *as a whole*, but neither prior art patent is at all concerned therewith. The Examiner himself states the Herrmann patent provides the frame 60, 62 "for the purpose [sic] providing trim" on front and/or back edges of the shelf "while leaving the edge portion untrimmed." The trim pieces 60, 62 are "optional" (column 4, lines 4-17) and are designed for aesthetic purposes only. Quite possible, a secondary purpose of the trim pieces, particularly the trim piece 62 of Figure 3, would be to reflect light which is transmitted through the glass shelf panel 22. The latter is speculation on the part of the undersigned, and seemingly the trim pieces of this patent are strictly designed for "stylistic requirements" (column 5, lines 8-16). Accordingly, even though Applicant is not claiming anything remotely suggested by the prior art, the Examiner looks to nonanalogous prior art (Herrmann et al.) to select therefrom an optional disclosure for a purpose unrecognized by either patent, namely, "for the purpose of leaving the edge portion untrimmed." Neither the patentees nor Applicant are concerned with leaving a particular edge of a shelf "untrimmed." Applicant avoids side border portions for conductivity purposes, while Herrmann et al. utilizes side edges of the glass panel 22 to intimately adhere the glass panel 22 to the brackets 24 associated therewith under such intimate engagement that conductivity/air flow is of absolutely no consequence, as is evidenced by any of the cross sectional views of this patent.

Since the Examiner concedes that Herrmann et al provides trim at front and rear edges of a shelf, why is not such teaching utilized to provide trim strips at the front and rear edges of the Maier et al. shelf. That is all

that Herrmann et al. teaches. Yet, the Examiner apparently believes it would be obvious to remove the side edge borders in Maier et al. to expose the edges of the glass panel 15 between the front and rear borders thereof, yet to do so would render inoperative the supportability and/or slidability of the Maier et al. patent because of the elimination of the sliders 21, 21 (Figure 3) and the flanges 19! With due respect, if the Examiner is following the Herrmann teaching "as a whole," he has done so inappropriately because such renders inoperative the Maier et al. shelf for its intended purpose, namely, forward and rearward sliding of a shelf relative to a refrigerator compartment. With due respect, the Examiner has not reasonably and equitably considered the scope and content of the prior art "as a whole" in the application thereof as set forth in the rejection at page 3 of the outstanding office Action.

Turning to the "differences between the prior art and the claims at issue" (page 3 of Office Action, sentence numbered "2"), claim 1 has been maintained in its original scope with the word "slidable" being introduced to emphasize the structure and function thereof. Moreover, the underlined limitation added by the Amendment calls for the front and rear border members as being in sliding relationship to one of the horizontally aligned pair of shelf-supporting ledges which affords spacing between the piece of glass of the shelf and the ledges "whereby conductivity within the refrigerator compartment is enhanced." The latter structure and function are not found in the patent to Maier et al. and are not found in the patent to Herrmann et al. With due respect, since the "differences between the prior art" and claim 1 are material and are significant and clearly avoid the scope

and content of the latter patents "as a whole," the formal allowance of claim 1 is believed proper and would be most appreciated.

With respect to the dependent claims, each ought be allowed for the reasons advanced with respect to claim 1. However, many of the dependent claims lack a fair counterpart in the prior art. For example, the U-shaped configuration defined in claims 4 and 5 is nowhere to be found in the prior art, yet these claims have been rejected absent comment by the Examiner.

The undersigned acknowledges the Examiner's comments with respect to several of the other dependent claims, such as claim 6, 7, 11, etc. However, the undersigned totally disagrees with the Examiner's conclusion that "It is well settled that the method of manufacture cannot impart Patentability to a product where the product itself is known." In cases involving method or process limitations in article claims or product-by-process claims, the issue is not one of obviousness or nonobviousness but the burden of proof relative thereto. As is set forth in the MPEP at Section 2113: "The Patent Office bears a lesser burden of proof in making out a case of *prima facie* obviousness for product-by-process claims because of their peculiar nature 'than when a product is claimed in the conventional fashion'." As is the present case, the Examiner must first provide "a rationale intending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process." Once the latter is done, then "the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product." Where the Examiner has not provided a rationale showing that the product is obvious, as in this case, the burden of proof does not shift and the claims must be allowed. Hence, the withdrawal of the

rejection of claims 6, 7, etc. is likewise considered proper and would be most appreciated.

Several additional dependent claims have been made of record, all depending directly or indirectly from claim 1, to afford Applicant that additional protection to which he is clearly entitled. The formal allowance of the newly added dependent claims is likewise believed to be in order and would be most appreciated.

One final word is considered to be in order with respect to independent claims 17 and 37 which stand rejected over the Meir et al. and Herrmann et al. patents.

Claim 17 now calls for a "slidable" shelf which includes front and rear border members each having a lower surface with a lower surface of the glass piece of the shelf being "spaced above a plane through said front and rear border member lower surfaces whereby conductivity within an associated refrigerator compartment is enhanced." The latter is best illustrated in Figure 2 of Applicant's drawings, the upper shelf thereof, and the prior art lacks comparable structure. Accordingly, the formal allowance of claim 17 would be most appreciated.

Turning to claim 37, the last of the independent claims of record and under consideration, the shelf has again been defined as a "slidable shelf" having a "front border member." The last limitation calls for the entirety of the glass piece side edges as extending from the front border member through the rear edge of the piece of glass and the glass side edges being substantially completely exposed along the entire length thereof. Once again, the latter finds no counterpart in the prior art, and there is nothing suggestive of changing the length of the trim pieces 60, 62 of Herrmann et

al. for an undisclosed purpose. Therefore, claim 37 is considered to be directed to novel and unobvious subject matter, and the allowance thereof would be most appreciated.

In view of the foregoing, the formal allowance of this application at an early date is herewith respectfully requested.

Respectfully submitted,

DILLER, RAMIK & WIGHT

By: 

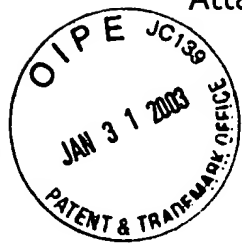
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09/892,503 of 6/28/01
Attachment to Amendment of filed on January 31, 2003



MARKED-UP SPECIFICATION AND CLAIMS

In the Specification:

Please amend paragraph [0003] as follows:

[0003] (Amended) A shelf similarly constructed from a single piece of tempered glass and having secured to a peripheral edge thereof a peripheral encapsulation, border or frame is disclosed in application Serial No.09/834,896 entitled a "Refrigerator Compartment Housing Vertically Adjustable Shelves" filed on April 16, 2001 in the name of Craig Bienick and now Patent No. [_____] 6,422,673 B1. The latter encapsulation is snap-secured to the glass panel, but the significance of this disclosure is that each shelf can be step-wise adjusted within an associated refrigerator compartment and is limited in its forward and rearward sliding movement by appropriate stops and abutments. Side border portions of the shelf are narrowed to accommodate stops or abutments carried by rails or guides of the refrigerator compartment.

In the Claims:

Please amend claims 1, 17 and 37 as follows:

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1. (Amended) A refrigerator compartment comprising substantially parallel side walls and a rear wall therebetween, a plurality of substantially vertically spaced shelf-supporting ledges along each of said side walls, said shelf-supporting ledges being disposed in substantially horizontally aligned pairs, at least one slidable shelf defined by a piece of glass and front and rear border members each made of polymeric/copolymeric molded synthetic material, said glass piece having opposite side edges and opposite front and rear edges, said front and rear border members having a respective glass piece front edge-receiving channel and a glass piece rear edge-receiving channel, said channels open in opposing relationship to each other, said glass piece front and rear edges being secured in the respective glass piece front edge-receiving and rear edge-receiving channels, said at least one slidable shelf being disposed with said front and rear border members in sliding relationship to one of said horizontally aligned pair of shelf-supporting ledges with said piece of glass being thereby spaced above said horizontally aligned pair of shelf-supporting ledges, and at least a portion of each glass piece side edge disposed between said front and rear border members being substantially completely exposed whereby conductivity within the refrigerator compartment is enhanced.

17. (Amended) A slidable shelf particularly adapted for use in a refrigerator compartment comprising a [price] piece of glass and front and rear border members each made of polymeric/ copolymeric molded synthetic material, each front and rear border member having a lower surface; said glass piece having upper and lower surfaces, opposite side edges and opposite front and rear edges[,]; said front and rear border members having a respective glass piece front edge-receiving channel and a glass piece rear edge-receiving channel, said channels open in opposing relationship to each other, said glass piece front and rear edges being secured in the respective glass piece front edge-receiving and rear edge-receiving channels, and at least a portion of each glass piece side edge disposed between said front and rear border members being substantially completely exposed with said glass piece lower surface being spaced above a plane through said front and rear border member lower surfaces whereby [conductivity] conductivity within [the] an associated refrigerator compartment is enhanced.

37. (Amended) A refrigerator compartment comprising substantially parallel side walls and a rear wall therebetween, a plurality of substantially vertically spaced shelf-supporting ledges along each of said side walls, said shelf-supporting ledges being disposed in substantially horizontally aligned pairs, at least one slidable shelf defined by a piece of glass and a front border member made of polymeric/copolymeric molded synthetic material, said glass piece having opposite side edges and opposite front and rear edges, said front border member having a glass piece front edge-receiving channel, said channel opens in a direction toward said glass piece rear edge, said glass piece front edge being secured in the glass piece front edge-receiving channel, and [at least a major portion] the entirety of said glass piece side edges [and] extending from said front border member through said rear edge [members] and being substantially completely exposed along the entire length thereof whereby conductivity within the refrigerator compartment is enhanced.

NOT CLEAR
IN 37 How exposing
The glass edge enhances
conductivity